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EXAMINER	
MURPHY, DILLON J	
ART UNIT	**PAPER NUMBER**
2625	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/021,340	SIMPSON ET AL.	
	Examiner	Art Unit	
	Dillon J. Murphy	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

- This action is responsive to the amendment filed on February 13, 2006.
- Claims 1, 2, and 4-27 are pending. Claims 1, 4, 5, 7, 8, 10, 11, 19, and 24 are amended. Claim 3 was previously canceled.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2006 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Lo et al. (US 6268927), hereafter Lo.

Regarding claim 1, Lo teaches a method practiced by a printing device for generating a form (Lo, col 3, ln 20-25, form printing), the method comprising:

Receiving with the printing device data to be included in a form to be printed and merging the received data with static form data already stored on the printing device (Lo, col 5, ln 64-col 6, ln 2, wherein user data is received by the printing device and the data is overlaid, i.e. merged, on the EPS form image, i.e. static form data. Also see figure 3 for an overview of receiving dynamic data and merging received data with static data. In col 5, ln 38-40, static form data is stored on the storage device, and in col 5, ln 20-25, printer may include an internal mass storage device, #3 of fig 3); and

Printing the received data and the already stored static form data together as a hard copy of the form (Lo, fig 3, received data, i.e. user data, and already stored static form data, i.e. form in storage #3, are printed together as composite image "form + data". Also see col 5, ln 64-col 6, ln 2), such that printing a hard copy form is possible without the need to send the static form data to the printing device and such that a copy of the static form data need only be stored on the printing device (Lo, col 6, ln 60-67, only dynamic data is sent. In col 11, ln 41-42, and Table 1, dynamic data is downloaded to printer without static data showing time savings. Also see col 12, ln 15-17, wherein form need only be stored on the mass storage device, previously shown to be incorporated into printer).

Regarding claim 5, claim 5 recites identical features as claim 1 except that claim 5 is a system claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 5. Applicant's attention is directed to fig 4 of Lo to printer #1 and storage #3, wherein storage may be included internally in printer, col 5, ln 20-25.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 6, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo in view of LeClair et al. (US 6,636,891) and further in view of Pennell et al. (US 6910179), hereafter referred to as Lo, LeClair, and Pennell.

Regarding claim 2, which depends from claim 1, Lo teaches a method practiced by a printing device for generating a form comprising receiving printing data by the printer, merging the received data and the already stored static form data, and printing the printing data and the static data, such that printing a hard copy is possible without the need to send the static form data to the printing device, as explained above in the rejection of claim 1. Lo does not disclose expressly a method wherein receiving data comprises receiving data with a web-based form processing service. LeClair, however, teaches a method of receiving data by a web-based service hosted by a printer (LeClair,

col 7, ln 55-59, printer hosts processing in embedded server, and col 8, ln 1-3, user invokes a browser connected to internet to submit information).

Lo and LeClair are combinable because they are from the same field of endeavor of printing systems and data control. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of LeClair comprising receiving data by a web based service hosted by a printer with the method of Lo comprising generating a form comprising receiving printing data by the printer, merging the received data and the already stored static form data, and printing the printing data and the static data, such that printing a hard copy is possible without the need to send the static form data to the printing device. The motivation for doing so would have been to allow multiple computer workstations or personal computers to share input and output devices (LeClair, col 1, ln 17-20). Additionally, the suggestion for doing so was given by Lo in col 5, ln 31-35, teaching a utility stored in the printer to facilitate file downloading and file management procedures.

The combination of Lo and LeClair teaches a method practiced by a printing device for generating a form comprising receiving printing data by the printer via a web-based service, merging the received data and the already stored static form data, and printing the printing data and the static data, such that printing a hard copy is possible without the need to send the static form data to the printing device. The combination of Lo and LeClair does not disclose expressly a method wherein the form processing is web-based. Pennell, however, teaches a method for inputting form data via a browser (Pennell, col 2, ln 11-12).

Lo, LeClair, and Pennell are combinable because they are from a similar field of endeavor of data processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of Pennell comprising web-based form processing with the combination of Lo and LeClair comprising a method practiced by a printing device for generating a form comprising receiving printing data by the printer via a web-based service, merging the received data and the already stored static form data, and printing the printing data and the static data, such that printing a hard copy is possible without the need to send the static form data to the printing device. The motivation for doing so would have been to allow any user regardless of their location to access the form processing features as taught by Lo and LeClair. Therefore, it would have been obvious to combine Pennell with the combination of Lo and LeClair to obtain the invention as specified in claim 2.

Regarding claim 6, which depends from claim 5, claim 6 recites identical features as claim 2 except that claim 6 is a system claim. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 5. Applicant's attention is directed to fig 4 of Lo to printer #1 and storage #3, wherein storage may be included internally in printer, col 5, ln 20-25. Additionally, see fig 3 of LeClair, showing I/O device (printer) #350 and server #310 along with col 7, ln 54-59, wherein printer may contain an embedded server. Furthermore, see fig 3 of Pennell, disclosing browser #303 on user computer #304.

Regarding claim 8, the combination of Lo, LeClair, and Pennell teaches a printing device comprising:

Hard copy generation hardware (Lo, fig 4, printer #1 and storage #3, wherein storage may be included internally in printer, col 5, ln 20-25. Also see fig 3 of LeClair, showing I/O device (printer) #350 and server #310 along with col 7, ln 54-59, wherein printer may contain an embedded server);

A processing device (LeClair, col 5, ln 25-38, wherein printer comprises controller shown in fig 4, wherein controller comprises processor #406); and

Memory including an embedded network server (LeClair, printer of LeClair comprises embedded network server, col 7, ln 54-59. Network server is stored in memory of controller, col 5, ln 39-57), the server hosting a form processing service (Pennell, col 2, ln 11-12, form processing occurs in browser as hosted by printer of LeClair) configured to merge data received with static form data already stored on the printing device to generate a completed form and print the received data and the already stored static form data together as a hard copy form (Lo, fig 3, received data, i.e. user data, and already stored static form data, i.e. form in storage #3, are printed together as composite image "form + data". Also see col 5, ln 64-col 6, ln 2);

Wherein printing a hard copy form is possible with the printing device without the need to send the static form data to the printing device and wherein a copy of the static form data need only be stored on the printing device (Lo, col 6, ln 60-67, only dynamic data is sent. In col 11, ln 41-42, and Table 1, dynamic data is downloaded to printer without static data showing time savings. Also see col 12, ln 15-17, wherein form need only be stored on the mass storage device, previously shown to be incorporated into printer).

Regarding claim 9, which depends from claim 8, the combination of Lo, LeClair, and Pennell teaches a printing device wherein the form processing service includes logic configured to present a form processing website to a user with which the received data can be provided (LeClair, col 7, ln 55-59, server (#310 of figure 3) may be embedded in printer. In col 6, ln 36-38, server is coupled to display, wherein display presents browser to user. Additionally, see col 2, ln 44-60 of Pennell, wherein a browser is taught to display the web-based server features of LeClair, and wherein the logical browser programs present a form processing website to a user (Pennell, fig 4) so that the printer may receive data).

Regarding claim 10, which depends from claim 8, the combination of Lo, LeClair, and Pennell teaches a printing device wherein the form processing service includes logic configured to store a copy of the completed form in a personal imaging repository of a user that initiated printing of the form, the personal imaging repository being remote from the printing device (LeClair, col 6, ln 50-56, printer contains memory for storing images and programs. Additionally, it is well known that a user operating a browser as disclosed by Pennell may save a copy of the completed form on their computing device, i.e. logic is provided to store a copy of a form in personal imaging repository remote from a printing device).

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo in view of Irons et al. (US 6952281), hereafter Lo and Irons.

Regarding claim 4, which depends from claim 1, Lo teaches a method practiced by a printing device for generating a form comprising receiving printing data by the printer, merging the received data and the already stored static form data, and printing the printing data and the static data, such that printing a hard copy is possible without the need to send the static form data to the printing device, as explained above in the rejection of claim 1. Lo does not disclose expressly a method further comprising storing an electronic copy of the completed form in a personal imaging repository of a user that initiated printing of the form, the personal imaging repository being remote from the printing device. Irons, however, teaches a method comprising storing an electronic copy of the completed form in a personal imaging repository of a user that initiated printing of the form (The method of Irons relates to a digital filing system for archiving paper documents or digital images. See Irons, col 7, ln 50-65, wherein documents already printed, i.e. a completed form, may be scanned into an electronic format and stored. See col 7, ln 66-col 8, ln 13, wherein digital document images may be stored in an image storage mechanism #130 of fig 1 and 2, for example), the personal imaging repository being remote from the printing device (Irons, col 11, ln 45-59, image repository. Also see fig 2, wherein image storage #130 comprises image repository #226. Images will be stored remotely, col 9, ln 30-38. Image repository is unique to user, col 15, ln 42-50).

Lo and Irons are combinable because they are from a similar field of endeavor of network printing and data management. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of Irons

comprising storing an electronic copy of the completed document in a remote image repository with the method of Lo practiced by a printing device for generating a form comprising receiving printing data by the printer, merging the received data and the already stored static form data, and printing the printing data and the static data, such that printing a hard copy is possible without the need to send the static form data to the printing device. The motivation for doing so would have been to provide for easy and effective indexing, imaging, toring, retrieving and managing of paper-based documents, transforming them into electronic documents using a system which incorporates many existing office resources (Irons, col 4, ln 33-37). Therefore, it would have been obvious to combine Irons with Lo to obtain the invention as specified in claim 4.

Regarding claim 7, which depends from claim 5, claim 7 recites identical features as claim 4 except that claim 7 is a system claim. Thus, arguments similar to that presented above for claim 4 are equally applicable to claim 7. Applicant's attention is directed to fig 4 of Lo to printer #1 and storage #3, wherein storage may be included internally in printer, col 5, ln 20-25.

Claims 11-13, 15, 19, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Hussein (US 5,809,167) in view of Lo, hereafter referred to as Al-Hussein and Lo.

Regarding claim 11, Al-Hussein teaches a method practiced by a printing device for printing a document comprising the steps of accessing document imaging data from at least one store via a network with the printing device (Al-Hussein, col 6, ln 12-16, files

are accessed from network disk. Additionally, the actions are performed by the printer itself, which comprises a general purpose computer, col 5, ln 53-60. Thus, any actions performed on any general purpose computer may be performed within the personal imaging computer system (PICS) of Al-Hussein), retrieving the document imaging data from the at least one store, and printing the document imaging data with the printing device (Al-Hussein, col 6, ln 22-25, method comprises retrieving the document image and associated text file and printing at a printer). Al-Hussein does not disclose expressly the method of merging and printing form data, although form data falls under the category of a document. Lo teaches a method practiced by a printing device for printing a form comprising merging the retrieved form imaging data with the already stored static form data on the printing device to generate a completed form (Lo, col 5, ln 64-col 6, ln 2, wherein user data is received by the printing device and the data is overlaid, i.e. merged, on the EPS form image, i.e. static form data. Also see figure 3 for an overview of receiving dynamic data and merging received data with static data. In col 5, ln 38-40, static form data is stored on the storage device, and in col 5, ln 20-25, printer may include an internal mass storage device, #3 of fig 3), and printing the form imaging data along with the already stored static form data together as a hard copy form (Lo, fig 3, received data, i.e. user data, and already stored static form data, i.e. form in storage #3, are printed together as composite image "form + data". Also see col 5, ln 64-col 6, ln 2), such that printing a hard copy form is possible without the need to send the static form data to the printing device and such that a copy of the static form data need only be stored on the printing device (Lo, col 6, ln 60-67, only dynamic data is

sent. In col 11, ln 41-42, and Table 1, dynamic data is downloaded to printer without static data showing time savings. Also see col 12, ln 15-17, wherein form need only be stored on the mass storage device, previously shown to be incorporated into printer).

Al-Hussein and Lo are combinable because they are in the same field of endeavor of printing systems and data control. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of merging the retrieved form imaging data with the already stored static form data on the printing device of Lo, and printing the form such that printing a hard copy is possible without the need to send the static form data to the printing device with the methods of Al-Hussein comprising accessing, retrieving, and printing document data by the printer. The motivation for doing so would have been to access files for printing remotely, as well as to retrieve a document image and text file for later printing (Al-Hussein, col 3, ln 51-55). Additionally, the suggestion for accessing and retrieving files with the printing device was given by Lo in col 5, ln 31-35, teaching a utility stored in the printer to facilitate file downloading and file management procedures. Therefore, it would have been obvious to combine Lo with Al-Hussein to obtain the invention as specified in claim 11.

Regarding claim 12, which depends from claim 11, the combination of Al-Hussein and Lo further teaches a method wherein the at least one store comprises a graphic store and a composition store (Al-Hussein, col 7, ln 39-51, images and text are stored in memory).

Regarding claim 13, which depends from claim 11, the combination of Al-Hussein and Lo further teaches a method wherein the at least one store is associated with an imaging service stored on the printing device that is configured to facilitate form completion (Al-Hussein, col 7, ln 39-51, CPU associated with imaging service controls program instruction sequences which manipulate document images. Word processor, image processing, and spreadsheet processing, i.e. programs for form processing, are stored in the PICS of Al-Hussein, col 5, ln 60-67).

Regarding claim 15, which depends from claim 11, the combination of Al-Hussein and Lo further teaches a method wherein accessing form imaging data comprises accessing imaging data through use of an imaging extension (Al-Hussein, col 7, ln 39-51, CPU associated with imaging service controls program instruction sequences which access and manipulate document images. Program of Al-Hussein provides generating and mapping of client instructions).

Regarding claim 19, the combination of Al-Hussein and Lo teaches a system stored on a printing device for printing a form, the system comprising:

Means provided on the printing device for accessing form imaging data form at least one store via a network (Al-Hussein, col 6, ln 12-16, files are accessed from network disk. Files are stored in server #41 on network disk #42, while being accessed via network #31 in figure 4. Also see Lo, fig 3, wherein user data is received from a network computer, col 5, ln 8-11);

Means for merging the retrieved form imaging data with static form data already stored of the printing device to generate a completed form (Lo, col 5, ln 64-col 6, ln 2,

wherein user data is received by the printing device and the data is overlaid, i.e. merged, on the EPS form image, i.e. static form data. Also see figure 3 for an overview of receiving dynamic data and merging received data with static data. In col 5, ln 38-40, static form data is stored on the storage device, and in col 5, ln 20-25, printer may include an internal mass storage device, #3 of fig 3); and

Means for printing the form imaging data along with the already stored static form data together as a hard copy form (Lo, fig 3, received data, i.e. user data, and already stored static form data, i.e. form in storage #3, are printed together as composite image "form + data". Also see col 5, ln 64-col 6, ln 2),

Wherein printing a hard copy form is possible with the system without the need to send the static form data to the printing device and wherein a copy of the static form data need only be stored on the printing device (Lo, col 6, ln 60-67, only dynamic data is sent. In col 11, ln 41-42, and Table 1, dynamic data is downloaded to printer without static data showing time savings. Also see col 12, ln 15-17, wherein form need only be stored on the mass storage device, previously shown to be incorporated into printer).

Regarding claim 24, the combination of Al-Hussein and Lo further teaches a printing device, comprising:

Memory (Al-Hussein, in figure 5, Personal Imagining Computer System #20, "PICS," comprises CPU #60, RAM Memory #79, ROM #77, and disk storage #75 for storing and executing instructions for image processing, col 7, ln 61-67 and col 8, ln 1-9), including logic configured to:

Access form imaging data (As explained in the rejection of claim 11, the document of Al-Hussein covers the forms as taught by Lo) from at least one store via a network (Al-Hussein, col 6, ln 12-16, files are accessed from network disk. Files are stored in server #41 on network disk #42, while being accessed via network #31 in figure 4. Also see Lo, fig 3, wherein user data is received from a network computer, col 5, ln 8-11),

Retrieve the form imaging data, merge the received data with static form data already stored on the printing device to generate a completed form (Lo, col 5, ln 64-col 6, ln 2, wherein user data is received by the printing device and the data is overlaid, i.e. merged, on the EPS form image, i.e. static form data. Also see figure 3 for an overview of receiving dynamic data and merging received data with static data. In col 5, ln 38-40, static form data is stored on the storage device, and in col 5, ln 20-25, printer may include an internal mass storage device, #3 of fig 3), and print the form imaging data along with the already stored static form data as a hard copy form (Al-Hussein, col 6, ln 22-25, method comprises retrieving the document image and associated text file and printing at a printer. Printer is shown as printer, #45, in figure 4. See also Lo, fig 3, wherein received data, i.e. user data, and already stored static form data, i.e. form in storage #3, are printed together as composite image "form + data". Also see col 5, ln 64-col 6, ln 2), wherein printing a hard copy form is possible with the printing device without the need to sent the static form data to the printing device and wherein a copy of the static form data need only be stored on the printing device (Lo, col 6, ln 60-67, only dynamic data is sent. In col 11, ln 41-42, and Table 1, dynamic data is downloaded to

printer without static data showing time savings. Also see col 12, ln 15-17, wherein form need only be stored on the mass storage device, previously shown to be incorporated into printer).

Regarding claim 25, which depends from claim 24, the combination of Al-Hussein and Lo further teaches a printing device wherein the logic comprises a network-based printing service (Al-Hussein, figure 4, printers #45, #20, and #56 are connected to LANs #32 and #46, respectively).

Claims 14, 16-18, 20-23, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Hussein in view of Lo and further in view of LeClair and further in view of Pennell.

Regarding claim 14, which depends from claim 13, the combination of Al-Hussein and Lo teaches a method practiced by a printing device for printing a form comprising accessing form image data, retrieving the form imaging data, merging the retrieved form imaging data with already stored static form data, and printing the form imaging data along with the already stored static form data as a hard copy, such that printing the hard copy is possible without the need to send the static data to the printing device, wherein at least one store is associated with an imaging service stored on the printing device. Although the combination of Al-Hussein and Lo teaches a method wherein the PICS is a general purpose computer combined with a printer connected to a network, the combination does not disclose expressly wherein the imaging service comprises a network-based form processing service hosted by the printing device. LeClair,

however, teaches a method of hosting a network-based imaging service hosted by a printer (LeClair, col 7, ln 55-59, printer hosts processing in embedded server, and col 8, ln 1-3, user invokes a browser connected to internet to submit and receive information).

Al-Hussein, Lo and LeClair are combinable because they are from the same field of endeavor of printing systems and data control. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of LeClair comprising hosting a network based imaging service hosted by a printer with the method of Al-Hussein and Lo comprising accessing form image data, retrieving the form imaging data, merging the retrieved form imaging data with already stored static form data, and printing the form imaging data along with the already stored static form data as a hard copy, such that printing the hard copy is possible without the need to send the static data to the printing device, wherein at least one store is associated with an imaging service stored on the printing device. The motivation for doing so would have been to allow multiple computer workstations or personal computers to share input and output devices (LeClair, col 1, ln 17-20).

The combination of Al-Hussein, Lo, and LeClair teaches a method practiced by a printing device for generating a form comprising accessing form image data, retrieving the form imaging data, merging the retrieved form imaging data with already stored static form data, and printing the form imaging data along with the already stored static form data as a hard copy, such that printing the hard copy is possible without the need to send the static data to the printing device, wherein at least one store is associated with an imaging service stored on the printing device, and wherein the imaging service

comprises a network-based processing service hosted by the printing device. The combination of Al-Hussein, Lo and LeClair does not disclose expressly a method wherein the form processing is web-based. Pennell, however, teaches a method for inputting form data via a browser (Pennell, col 2, ln 11-12).

Al-Hussein, Lo, LeClair, and Pennell are combinable because they are from a similar field of endeavor of data processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of Pennell comprising web-based form processing with the combination of Al-Hussein, Lo, and LeClair comprising a method practiced by a printing device for generating a form comprising accessing form image data, retrieving the form imaging data, merging the retrieved form imaging data with already stored static form data, and printing the form imaging data along with the already stored static form data as a hard copy, such that printing the hard copy is possible without the need to send the static data to the printing device, wherein at least one store is associated with an imaging service stored on the printing device, and wherein the imaging service comprises a network-based processing service hosted by the printing device. The motivation for doing so would have been to allow any user regardless of their location to access the form processing features as taught by the combination of Al-Hussein, Lo, and LeClair. Therefore, it would have been obvious to combine Pennell with the combination of Al-Hussein, Lo, and LeClair to obtain the invention as specified in claim 14.

Regarding claim 16, which depends from claim 15, the combination of Al-Hussein, Lo, LeClair, and Pennell teaches a method practiced by a printing device for

printing a form, wherein the imaging extension comprises part of a user browser (LeClair, col 8, ln 1-3, printing commands are issued from a browser over the internet. Also see Pennell, fig 4, wherein the browser is used for form processing. It is well known that a browser as taught by Pennell and LeClair comprises at least one imaging extension such as WinSock API).

Regarding claim 17, which depends from claim 15, the combination of Al-Hussein, Lo, LeClair and Pennell teaches a method practiced by a printing device for printing a form wherein the imaging extension comprises part of a network-based printing service hosted by the printing device (LeClair, col 7, ln 57-65, instructions issued to retrieve documents are sent by browser, col 8, ln 1-3, which is hosted by printing device, in network connected to printer figure 3, I/O device #350 connected to network #300, browser is viewed in display #322, connected to server #310 and network. Also see col 9, ln 30-34 of LeClair, wherein a print request printing the forms as taught by Lo, may be received by the network based printing device. It is well known in the art that a browser as taught by Pennell and LeClair comprises at least one imaging extension such as WinSock API).

Regarding claim 18, which depends from claim 17, the combination of Al-Hussein, Lo, LeClair, and Pennell teaches a method wherein the printing service is hosted by an embedded server of the printing device (LeClair, col 7, ln 55-59, printer hosts processing in embedded server. Processing occurs in server in printer to process images comprising documents and forms).

Regarding claim 20, which depends from claim 19, the combination of Al-Hussein, Lo, LeClair, and Pennell teaches a system stored on a printing device for printing a form wherein the means for accessing form imaging data comprises an imaging extension (Al-Hussein, col 7, ln 39-51, CPU associated with imaging service controls program instruction sequences which access and manipulate document images. In figure 5, disk #75, where image and text files are stored, is interfaced with SCSI interface #76 to computer bus #61. Also see, LeClair, col 8, ln 1-3, printing commands are issued from a browser over the Internet. Also see Pennell, fig 4, wherein the browser is used for form processing. It is well known that a browser as taught by Pennell and LeClair comprises at least one imaging extension such as WinSock API).

Regarding claim 21, which depends from claim 20, the combination of Al-Hussein, Lo, LeClair, and Pennell teaches a system stored on a printing device for printing a form wherein the imaging extension comprises part of a user browser (LeClair, col 8, ln 1-3, printing commands are issued from a browser over the internet. Also see Pennell, fig 4, wherein the browser is used for form processing. It is well known in the art that a browser as taught by Pennell and LeClair comprises at least one imaging extension such as WinSock API).

Regarding claim 22, which depends from claim 20, the combination of Al-Hussein, Lo, LeClair, and Pennell teaches a system stored on a printing device for printing a form wherein the imaging extension comprises part of a network-based printing service hosted by the printing device (LeClair, col 7, ln 57-65, instructions

issued to retrieve documents are sent by browser, col 8, ln 1-3, in network connected to printer (figure 3), I/O device #350 connected to network #300, browser is viewed in display #322, connected to server #310 and network. Embedded server of LeClair may host form process website as taught by Pennell. Additionally, it is well known in the art that a browser as taught by Pennell and LeClair comprises at least one imaging extension such as WinSock API).

Regarding claim 23, which depends from claim 22, the combination of Al-Hussein, Lo, LeClair, and Pennell teaches a system stored on a printing device for printing a form wherein the printing service is hosted by an embedded server of the printing device (LeClair, col 7, ln 57-65, instructions issued to retrieve documents are sent by browser, col 8, ln 1-3, which is hosted by printing device, in network connected to printer figure 3, I/O device #350 connected to network #300, browser is viewed in display #322, connected to server #310 and network. Also see col 9, ln 30-34 of LeClair, wherein a print request printing the forms as taught by Lo, may be received by the network based printing device. It is well known in the art that a browser as taught by Pennell and LeClair comprises at least one imaging extension such as WinSock API).

Regarding claim 26, which depends from claim 24, the combination of Al-Hussein, Lo, LeClair, and Pennell further teaches a printing device wherein the logic comprises an imaging extension that is configured to access the at least one store (Al-Hussein, col 8, ln 67 and continuing to col 9, ln 1-8, program of PICS includes logic for an imaging extension configured to access at least one store, i.e. the program has capabilities to create, store, and access text files and associated image files from

various storage media. Also see LeClair, col 8, ln 1-3, printing commands are issued from a browser over the internet. Also see Pennell, fig 4, wherein the browser is used for form processing. It is well known in the art that a browser as taught by Pennell and LeClair comprises at least one imaging extension such as WinSock API).

Regarding claim 27, which depends from claim 24, the combination of Al-Hussein, Lo, LeClair, and Pennell teaches a printing system further comprising an embedded server (LeClair, col 7, ln 55-59, printer comprises an embedded server. In figure 3, server #310 may be embedded in I/O device #350. Processing occurs in server in printer to process images comprising documents and forms).

Response to Arguments

Applicant's arguments, see Remarks, pages 9-13, filed February 13, 2006, with respect to the rejection(s) of claim(s) 1, 2, and 4-27 under 35 U.S.C 102b and 35 U.S.C. 103, respectively, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Lo et al. (US 6268927).

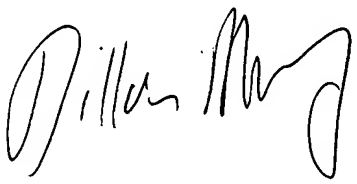
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon J. Murphy whose telephone number is (571) 272-5945. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJM



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